

**Amendment and Response**

Applicant: Michael F. Hoey et al.

Serial No.: 10/699,548

Filed: October 31, 2003

Docket No.: M190.133.102

Title: APPARATUS AND METHOD FOR CREATING, MAINTAINING, AND CONTROLLING A VIRTUAL ELECTRODE USED FOR THE ABLATION OF TISSUE

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**REMARKS**

These remarks are made in response to the Non-Final Office Action mailed June 1, 2005. In that Office Action, the Examiner rejected claims 6-16, 19-32, 35-45, and 48 under 35 U.S.C. §102(b) as being anticipated by Jackson et al., U.S. Patent No. 5,383,874 ("Jackson"). Claims 17, 18, 33, 34, 46, and 47 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jackson in view of the teaching of Nardella, U.S. Patent No. 5,334,193 ("Nardella").

With this Response, claims 6, 7, 9, 19, 20, 22, 35-37, and 48 have been amended. Claims 6-48 remain pending in the application and are presented for reconsideration and allowance.

**35 U.S.C. §§102 & 103 Rejections**

Independent claims 6, 20, and 36 stand rejected under 35 U.S.C. §102(b) as being anticipated by Jackson. Additionally, several dependent claims stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jackson in view of Nardella. In general terms, independent claims 6, 20, and 36 as amended relate, in part, to a memory chip or means for providing or delivering a predetermined time limit for an operating parameter or identifying characteristic.

Support for such amendments can be found throughout the Specification, for example: Table 5 (e.g., typical pre-ablation time for new placement of 30 sec; typical pre-ablation flow time of 5 sec) and Table 7 (e.g., typical power reduction duration of 3 sec), and Table 8 (e.g., typical primary temp maintain time of 1 min.; typical max. ablation time of 10 min.). For at least the reasons described below, the cited references fail to teach or suggest such limitations.

At column 7, lines 39-43, Jackson discloses: "A micro-chip can be pre-programmed with a digital value representing a catheter identification code and other information. In this way, the catheter itself can be programmed to store information about its operational and functional characteristics." However, Jackson does not teach or suggest a predetermined time period for an operating parameter or identifying characteristic.

For example, claims 10, 25, and 38 were rejected as anticipated by Jackson and relate, in part, to an exemplary predetermined time limit. In particular, claims 10, 25, and 38 relate to limiting the total amount of time the ablating energy is delivered to a surgical instrument. As

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another example, claims 11, 26, and 39 were rejected under 35 U.S.C. § 102(b) and relate, in part, to a time limit within which a surgical instrument must be used. It would appear that the Examiner rejected those claims when interpreting Jackson to disclose that “[t]he processor is adapted to limit the number of times the device may be used.” *NFOA* at 2. However, the number of times a device is used is not otherwise a time limit, it simply relates to a number of occurrences.

Nardella is also unavailing in this respect. In order to meet the limitations of dependent claims 17, 18, 33, 34, 46, and 47, the Office Action cites the combination of Nardella with Jackson to provide a conductive fluid and means to control the fluid flow, and therefore a motivation to “store[] information regarding the fluid-flow parameters” as “an obvious consideration for one of ordinary skill in the art.” *NFOA* at pg. 3. However, Nardella also fails to teach or suggest a memory chip or means for providing or delivering a predetermined time limit for an operating parameter. Even if “flow rate” as referenced by Nardella is considered “time dependent,” Nardella does not teach or suggest providing time limit associated with a flow rate. As the remainder of Nardella is silent in this respect, Nardella also fails to teach or suggest the limitations of the independent claims.

Furthermore, with respect to claims 18, 34, and 47, Nardella does not teach that flow rate is an operating parameter or identifying characteristic. In particular, Nardella teaches that flow rate is “preferably variable.” *Nardella* at column 6, lines 37-39 (emphasis added). In other words, Nardella teaches that fluid flow rate is controlled by impedance or temperature. A particular impedance or temperature is continuously monitored and selected as an operating parameter, and flow rate is increased or decreased according to those operating parameters, i.e., temperature and/or impedance. *Nardella* at column 6, lines 35-55. Thus, Nardella fails to teach or suggest that flow rate is an operating parameter or identifying characteristic as required by the limitations of dependent claims 18, 34, and 47. Accordingly, those claims are allowable for at least such additional reasons.

In light of the above, the cited references fail to teach or suggest the limitations of independent claims 6, 20, and 36 either alone, or in combination. As such, the rejection of those

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claims under 35 U.S.C. §102(b) is respectfully traversed. Additionally, claims 8-19, 21-35, and 37-48 depend, in some form, from independent claims 6, 20, and 36. As such, the rejection of those claims under 35 U.S.C. §102(b) or 35 U.S.C. § 103(a) is respectfully traversed for reasons similar to those described in association with the independent claims.

**CONCLUSION**

In view of the above, Applicant respectfully submits that pending claims 6-48 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 6-48 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiries may be directed to Timothy A. Czaja at Telephone No. (612) 573-2004, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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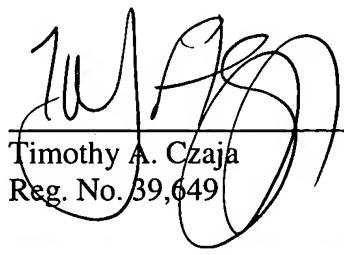
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**CERTIFICATE UNDER 37 C.F.R. 1.8:**

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 1<sup>st</sup> day of September, 2005.

By 

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